

REMARKS

In the Final Office Action,¹ the Examiner took the following actions:

- 1) rejected claims 1, 7, 9, 15, 17, 23, 25-34, and 36-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,177,932 to Galdes et al. ("*Galdes*") in combination with U.S. Patent No. 6,999,990 to Sullivan et al. ("*Sullivan*"); and
- 2) rejected claims 8, 16, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Galdes* in combination with *Sullivan* and further in view of U.S. Patent No. 5,937,392 to Alberts ("*Alberts*").

By this Amendment, Applicant has cancelled claims 31-33, rendering the rejection thereof moot. Claims 1, 7-9, 15-17, 23-30, 34, and 36-40 remain pending in this application. Applicant respectfully traverses the above rejections for the following reasons.

I. Rejection of Claims 1, 7, 9, 15, 17, 23, 25-34, and 36-40 under 35 U.S.C. § 103(a):

Applicant respectfully traverses the rejection of claims 1, 7, 9, 15, 17, 23, 25-34, and 36-40 under 35 U.S.C. § 103(a) as being unpatentable over *Galdes* in view of *Sullivan*.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is

¹ The Final Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 1, as amended, recites a combination including “generating an identification code in accordance with the received click information” (emphases added). *Galdes* and *Sullivan*, taken either alone or in combination, fail to teach at least this element.

The Office Action admitted that “*Galdes* does not teach wherein an ID code is generated by a series of mouse clicks, wherein the code contains information regarding the query contents.” Office Action, p. 3. However, the Office Action applied *Sullivan* and alleged that *Sullivan* teaches “a ‘code’ regarding information pertaining to the ‘query contents,’ based on a previous series of clicks as the user navigates through the help system.” *Id.* This is not correct.

Sullivan does not cure the deficiencies of *Galdes*. *Sullivan* discloses a guided self-help system to provide automated guidance to a user for solving his or her technical problem. See *Sullivan*, col. 2, ll. 17-24. *Sullivan* further discloses that the self-help system has “a mechanism for transferring (from the user’s system to the support center server) information about all user attempts to solve the problem” for a support engineer

to immediately access “the past history of the user’s attempts to rectify the problem.” *Sullivan*, col. 2, ll. 43-50. However, *Sullivan*’s history information of the user’s attempts to solve the problem within the self-help interface cannot constitute “an identification code in accordance with the received click information,” as recited in amended claim 1. This is evidenced in the description of the history information in *Sullivan*. For example, *Sullivan* discloses that “the self-help actions the user took” (i.e., the history information) include “all search strings and those actually traversed.” *Sullivan*, col. 12, ll. 19-22. *Sullivan* further discloses that “the search string [] is a value that, when fed into the technical support server’s search engine 50, should produce relevant hits, namely, information for solving the technical problem.” *Sullivan*, col. 9, ll. 33-36. That is, *Sullivan*’s history information only includes search queries and resulting solution information. Contrary to the Examiner’s allegation, *Sullivan* does not disclose anything about “generating an identification code in accordance with the received click information,” as recited in amended claim 1 (emphasis added).

In view of the above, neither *Galdes* nor *Sullivan* teaches or suggests “generating an identification code in accordance with the received click information,” as recited in amended claim 1. Accordingly, the Office Action has neither properly determined the scope and content of the prior art, nor properly ascertained the differences between the claimed invention and the prior art. Therefore, no reason has been clearly articulated as to why *Galdes* and *Sullivan* would have rendered the claimed invention obvious to one of ordinary skill in the art. No *prima facie* case of obviousness has been established, and claim 1 is thus allowable over *Galdes* and *Sullivan*.

Independent claims 9, 17, 25-30, and 34, while of different scope, contain similar recitations as claim 1, and are therefore also allowable over *Galdes* and *Sullivan* for at least the reasons set forth above with respect to claim 1.

Claims 7 and 38 depend from claim 1, claims 15 and 39 depend from claim 9, claims 23 and 40 depend from claim 17, and claims 36 and 37 depend from claim 34. Therefore, these dependent claims require all the limitations of their respective base claim. Accordingly, claims 7, 15, 23, and 36-40 are allowable over *Galdes* and *Sullivan* at least due to their dependence from allowable independent claims.

II. Rejection of Claims 8, 16, and 24 Under 35 U.S.C. § 103(a):

Applicant respectfully traverses the rejection of claims 8, 16, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Galdes* in combination with *Sullivan* and further in view of *Alberts*.

As set forth above, neither *Galdes* nor *Sullivan* teaches or suggests at least “generating an identification code in accordance with the received click information,” as recited in claim 1 (with similar recitations in claims 9 and 17) and required by claims 8, 16, and 24 depended from claims 1, 9, and 17, respectively. The Examiner cited *Alberts* against claims 8, 16, and 24 as allegedly teaching subject matter recited in claims 8, 16, and 24. Even assuming the Examiner’s characterization of *Alberts* is correct, which Applicant does not concede, *Alberts* still fails to cure the deficiencies of *Galdes* and *Sullivan*, discussed above. That is, *Alberts* also fails to teach at least “generating an identification code in accordance with the received click information,” as recited in claim 1 (with similar recitations in claims 9 and 17) and required by claims 8, 16, and 24 depended from claims 1, 9, and 17, respectively. Therefore, the Office Action has neither properly determined the scope and content of the prior art, nor properly ascertained the differences between the claimed combinations and the prior art. Accordingly, no reason has been clearly articulated as to why *Galdes*, *Sullivan*, and *Alberts* would have rendered the claimed invention obvious to one of ordinary skill in the art. No *prima facie* case of obviousness has been established, and claims 8, 16, and 24 are thus allowable over *Galdes*, *Sullivan*, and *Alberts*.

III. Conclusion:

In view of the foregoing amendments and remarks, Applicant respectfully requests the Examiner to enter this Amendment under 37 C.F.R. § 1.116, placing claims 1, 7-9, 15-17, 23-34, and 36-40 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 9, 17, 25-30, 34, and 37 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Applicant further submits that the entry of the amendments would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.



In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By:  #27432
 Andrew C. Sonu
Reg. No. 33,457